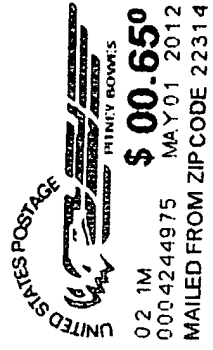


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ANDREW M CALDERON  
WHITHAM CURTIS & WHITHAM  
11800 SUNRISE VALLEY DRIVE  
SUITE 900  
RESTON VA 20191

In re Application of :  
Burdisso et al. :  
Application No. 09/159,634 :  
Patent No. 6,112,514 : DECISION ON PETITION  
Filed: September 24, 1998 : PURSUANT TO  
Issue Date: September 5, 2000 : 37 C.F.R. § 1.378(B)  
Attorney Docket Number: 97-058 :  
Title: FAN NOISE REDUCTION FROM :  
TURBOFAN ENGINES USING ADAPTIVE :  
HERSCHEL-QUINCKE TUBES :

This is a decision on the petition filed January 23, 2012, signed by an attorney or agent registered to practice before the Patent and Trademark Office pursuant to 37 C.F.R. § 1.378(b), to reinstate the above-identified patent.

The petition is **DISMISSED**.

The patent issued on September 5, 2000. The grace period for paying the 7½-year maintenance fee provided in 37 C.F.R. § 1.362(e) expired at midnight on September 5, 2008, with no payment received. Accordingly, the patent expired on September 5, 2008 at midnight.

With this petition, Petitioner submitted the surcharge associated with a petition to accept late payment of a maintenance fee as unavoidable, along with the 7½-year maintenance fee and several declarations of facts.

Any petition to accept an unavoidably delayed payment of a maintenance fee filed under 37 C.F.R. §1.378(b) must include:

- (1) the required maintenance fee set forth in 37 C.F.R. § 1.20 (e) through (g);
- (2) the surcharge set forth in 37 C.F.R. § 1.20(i)(1), and;
- (3) a showing that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent - the showing must enumerate the steps taken to ensure timely payment of the maintenance fee, the date and the manner in which patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly.

Petitioner has met the first and second requirements of 37 C.F.R. § 1.378(b). Regarding the third requirement, Petitioner's explanation of the delay has been considered, and it has been determined that it fails to meet the standard for acceptance of a late payment of the maintenance fee and surcharge. A discussion follows.

#### **The standard**

35 U.S.C. § 41(c)(1) states:

The Director may accept the payment of any maintenance fee... after the six-month grace period if the delay<sup>1</sup> is shown to the satisfaction of the Director to have been unavoidable.

Rule § 1.378(b)(3) is at issue in this case. Acceptance of a late maintenance fee under the unavoidable delay standard is considered under the same standard for reviving an abandoned application under 37 C.F.R. § 1.137(a). This is a very stringent standard. Decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

The word 'unavoidable' ... is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business.<sup>2</sup>

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<sup>1</sup> This delay includes the entire period between the due date for the fee and the filing of a grantable petition pursuant to 37 C.F.R. § 1.378(b).

<sup>2</sup> In re Mattullath, 38 App. D.C. 497, 514-15 (1912) (quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F.

In addition, decisions are made on a "case-by-case basis, taking all the facts and circumstances into account."<sup>3</sup> Nonetheless, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable."<sup>4</sup>

#### Docketing error

A delay resulting from an error (e.g., a docketing error) on the part of an employee in the performance of a clerical function may provide the basis for a showing of "unavoidable" delay.

Such a showing should identify the specific error,<sup>5</sup> the individual who made the error, and the business routine in place for performing the action that resulted in the error. The showing must establish that the individual who erred was sufficiently trained and experienced with regard to the function and routine for its performance that reliance upon such employee represented the exercise of due care. The showing should include information regarding the training provided to the personnel responsible for the docketing error, degree of supervision of their work, examples of other work functions carried out, and checks on the described work which were used to assure proper execution of assigned tasks.

A delay resulting from an error (e.g., a docketing error) on the part of an employee in the performance of a clerical function may provide the basis for a showing of "unavoidable" delay, provided it is shown that:

- (1) the error was the cause of the delay at issue,
- (2) a business routine was in place for performing the clerical function that could reasonably be relied upon to avoid errors in its performance, and;
- (3) the employee was sufficiently trained and experienced

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Supp. 550, 552, 138 U.S.P.Q. 666, 167-68 (D.D.C. 1963), aff'd, 143 U.S.P.Q. 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913).

3 Smith v. Mossinghoff, 671 F.2d at 538, 213 U.S.P.Q. at 982.

4 Haines v. Quigg, 673 F. Supp. at 316-17, 5 U.S.P.Q.2d at 1131-32.

5 Petitioner must identify the error that caused the delay. If the specific error cannot be identified, the petitioner must identify any and all possible causes and prove that any of them, if they were the true cause, constitute unavoidable delay. A full and complete discussion for each possible error must be presented. Petitioner is reminded that a petitioner has the burden of proof.

with regard to the function and routine for its performance that reliance upon such employee represented the exercise of due care.

See M.P.E.P. § 711.03(c) (III) (C) (2).

An adequate showing should include (when relevant):

- (1) statements by all persons with direct knowledge of the circumstances surrounding the delay, setting forth the facts as they know them;
- (2) a thorough explanation of the docketing and call-up system in use;
- (3) identification of the type of records kept;
- (4) identification of the persons responsible for the maintenance of the system;
- (5) copies of mail ledger, docket sheets, filewrappers and such other records as may exist which would substantiate an error in docketing;
- (6) include an indication as to why the system failed in this instance, and;
- (7) information regarding the training provided to the personnel responsible for the docketing error, degree of supervision of their work, examples of other work functions carried out, and checks on the described work which were used to assure proper execution of assigned tasks.

**Portions of the Code of Federal Regulations and the M.P.E.P.  
relevant to the abandonment of this application**

37 C.F.R. § 1.362 sets forth, in pertinent part:

(a) Maintenance fees as set forth in §§1.20(e) through (g) are required to be paid in all patents based on applications filed on or after December 12, 1980, except as noted in paragraph (b) of this section, to maintain a patent in force beyond 4, 8 and 12 years after the date of grant.

(d) Maintenance fees may be paid in patents without surcharge during the periods extending respectively from:

- (1) 3 years through 3 years and 6 months after grant for the first maintenance fee,
- (2) 7 years through 7 years and 6 months after grant for the second maintenance fee, and
- (3) 11 years through 11 years and 6 months after grant for the third maintenance fee.

(e) Maintenance fees may be paid with the surcharge set forth in

§ 1.20(h) during the respective grace periods after:

- (1) 3 years and 6 months and through the day of the 4th anniversary of the grant for the first maintenance fee.
- (2) 7 years and 6 months and through the day of the 8th anniversary of the grant for the second maintenance fee, and
- (3) 11 years and 6 months and through the day of the 12th anniversary of the grant for the third maintenance fee.

(f) If the last day for paying a maintenance fee without surcharge set forth in paragraph (d) of this section, or the last day for paying a maintenance fee with surcharge set forth in paragraph (e) of this section, falls on a Saturday, Sunday, or a federal holiday within the District of Columbia, the maintenance fee and any necessary surcharge may be paid under paragraph (d) or paragraph (e) respectively on the next succeeding day which is not a Saturday, Sunday, or Federal holiday.

(g) Unless the maintenance fee and any applicable surcharge is paid within the time periods set forth in paragraphs (d), (e) or (f) of this section, the patent will expire as of the end of the grace period set forth in paragraph (e) of this section. A patent which expires for the failure to pay the maintenance fee will expire at the end of the same date (anniversary date) the patent was granted in the 4th, 8th, or 12th year after grant.

M.P.E.P. 2515 sets forth, *in pertinent part*:

If a patent expires because the maintenance fee and any necessary surcharge have not been paid in the manner required by 37 C.F.R. 1.366, the patentee could proceed under 37 C.F.R. 1.378 (see MPEP § 2590), if appropriate, or could file a petition under 37 C.F.R. 1.377 (see MPEP § 2580) within the period set therein seeking to have the maintenance fee accepted as timely even though not all of the required identifying data was present prior to expiration of the grace period.

**Application of the standard to the current facts and  
circumstances**

The period for paying the 7½-year maintenance fee without the surcharge extended from September 5, 2007 to March 5, 2008 and for paying with the surcharge from March 6, 2008 to September 5, 2008. Thus, the delay in paying the 7½-year maintenance fee extended from September 5, 2008 at midnight to the filing of this petition on January 23, 2012.

Virginia Tech Intellectual Properties, Inc. (VTIP) is the Assignee of record. Mark Coburn is the President of VTIP, and has indicated that he has the responsibility of "tracking and

managing the intellectual property owned by VTIP,"<sup>6</sup> and he has been employed in this capacity since March 27, 2006.<sup>7</sup>

The relevant dates are as follows.

- Prior to May 1, 2008, the law firm of Whitham, Curtis, Christofferson & Cook P.C. (Whitham law firm) "was responsible for tracking and payment of maintenance fees for VTIP patents."<sup>8</sup>
- On September 5, 2007, the payment window for submitting the 7½-year maintenance fee opened.
- On May 1, 2008, VTIP "took over responsibility for tracking and payment of maintenance fees for VTIP's US patents."<sup>9</sup>
- On September 5, 2008, the payment window for submitting the 7½-year maintenance fee closed.

A declaration of facts from Michael E. Whitham of the Whitham law firm has been included with this petition, which states the Whitham law firm has "tracked and paid a great many patent maintenance fees...for VTIP patents from about the mid 1990's until 01 May 2008."<sup>10</sup> Mr. Whitman adds after reviewing the files of Whitham law firm, he has concluded "we did not receive instructions from VTIP to pay the second maintenance fee for the '514 patent and having received no instructions to do so, we did not pay the second maintenance fee for the '514 patent."<sup>11</sup>

However, it is noted that the maintenance fee window opened during the period when the Whitman law firm was responsible for tracking the maintenance fee, and the Whitman statement of facts is silent as to whether the Whitman law firm made an inquiry to VTIP as to whether or not the second maintenance fee should be paid. As such, the record establishes that for the first 239 days of the payment window (September 5 2007 - May 1, 2008) the responsibility of the tracking of the maintenance fee lay with the Whitham law firm, however the record does not describe any

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<sup>6</sup> Coburn declaration of facts, paragraphs 2 and 4.

<sup>7</sup> Id. at 2.

<sup>8</sup> Id. at 5.

<sup>9</sup> Id.

<sup>10</sup> Whitman statement of facts, paragraph 3.

<sup>11</sup> Id. at 4.

actions of the Whitham law firm that might have been taken during this time in regards to either notifying VTIP of the need to submit the 7½ year maintenance fee or submitting the 7½-year maintenance fee to the Office.

Mr. Coburn asserts that VTIP uses "Inteum C/S® technology transfer software for intellectual property," and this software is used "for tracking patent due dates including maintenance fee due dates."<sup>12</sup> Prior to May 1, 2008, during the period which the Whitham law firm was responsible for tracking maintenance fees, the Inteum C/S® software did not include "US. patent maintenance fee tracking information."<sup>13</sup> Mr. Coburn explains that on an unspecified date, Ms. Lucas (the IP Manager/Patent Paralegal of VTIP) wrote "Paid 8/9/06" in the "7.5 large entity" field of the Inteum C/S® tracking report, and this entry was erroneously made as a result of the fact that the 2006 annuity fee for the corresponding European Patent Application was made on this date. In other words, the annuity for the corresponding European Patent Application was paid on August 9, 2006, and Ms. Lucas erroneously placed an entry into the Inteum C/S® tracking report indicating that the maintenance fee for this U.S. Patent had been paid on this date.<sup>14</sup> It is not clear whether this erroneous entry in VTIP's docketing system was made during the period of time where the Whitham law firm was responsible for the tracking and payment of the maintenance fee, or whether the entry was made during the period of time where VTIP was responsible for the tracking and payment of the maintenance fee. As such, the record does not establish whether this mistaken entry resulted in the failure to submit the maintenance fee in a timely manner.

Moreover, the record does not explain why the maintenance fee was not submitted during the period of time when the responsibility of tracking the maintenance fee rested with the Whitman law firm. The maintenance fee window opened on September 5, 2007, and the record is silent as to why the Whitham law firm did not effectuate the submission of the maintenance fee during the time period when they were responsible for tracking the maintenance

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<sup>12</sup> Coburn declaration of facts, paragraph 4.

<sup>13</sup> Id. at 8.

<sup>14</sup> Id. at 12. See also Lucas declaration of facts, paragraph 8 and Exhibits A and B.



fee (from the opening of the maintenance fee window on September 5, 2007 through the termination of their responsibility for the tracking of maintenance fees on April 30, 2008, the day which precedes May 1, 2008). The record is silent as to any notification that might have been provided to VTIP from the Whitham law firm of the need to submit a maintenance fee, during the time period during which the Whitham law firm was responsible for the tracking and payment of the 7½ year maintenance fee.

Mr. Coburn has indicated he "did not order payment of the second maintenance fee for the '514 patent,"<sup>15</sup> and Mr. Whitham has confirmed this to be accurate in the fourth paragraph of his declaration of facts. Since it does not seem likely that Mr. Coburn would order the payment of the second maintenance fee during the period of time when he "was responsible for tracking and payment of maintenance fees for VTIP's US patents,"<sup>16</sup> these statements by Messrs. Coburn and Whitham seem to suggest the Whitham law firm provided no notification to VTIP that the second maintenance fee was due.

Petitioner has identified the date and the manner in which Patentee became aware of the expiration of the patent and has identified the steps taken to file the petition promptly.<sup>17</sup>

Petitioner has failed to sufficiently enumerate the steps taken to ensure timely payment of the maintenance fee. A discussion follows.

Petitioner has failed to establish a docketing error on the part of either the Whitham law firm or VTIP, for at least the following eleven reasons:

1. Petitioner has not sufficiently identified the error that was the cause of the delay at issue in regards to VTIP: the petition does not indicate the date on which Ms. Lucas made the erroneous entry of "Paid 8/9/06." Moreover, Petitioner has not identified the error that was the cause of the delay at issue in regards to the Whitham law firm. The record is silent as to why the 7½ year maintenance fee was not submitted during the

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<sup>15</sup> Coburn statement of facts, paragraph 13.

<sup>16</sup> *Id.* at 5.

<sup>17</sup> Petition, pages 6-7.

period of time which the Whitham law firm was responsible for the tracking and payment of the same.

2. Petitioner has not provided statements by all persons with direct knowledge of the circumstances surrounding the delay, setting forth the facts as they know them: a statement from the individual responsible for maintaining the docketing system at the Whitham law firm has not been located in the electronic file.
3. Petitioner has not provided a thorough explanation of the docketing and call-up system in use by VTIC, and has provided no explanation of the system in use by the Whitham law firm.
4. Petitioner has provided an identification of the type of records kept by VTIC, but not the type of records kept by Whitham law firm.
5. Petitioner has indicated that Ms. Lucas was responsible for the maintenance of the VTIP system, but has not provided an identification of the persons responsible for the maintenance of the system in use by the Whitham law firm;
6. Petitioner has provided a copy of the records which would substantiate an error in docketing during the period of time when VTIP was responsible for the tracking of the 7½ year maintenance fee, but has not provided copies of mail ledger, docket sheets, filewrappers and such other records as may exist which would substantiate an error in docketing during the period of time when the Whitham law firm was responsible for the tracking of the 7½ year maintenance fee;
7. Petitioner has provided an indication as to why the system failed in this instance during the time period when VTIP was responsible for the tracking of the 7½ year maintenance fee, but not for the period of time when the Whitham law firm was responsible for the tracking of the 7½ year maintenance fee;

8. Petitioner has not provided information regarding the training provided to either Ms. Lucas<sup>18</sup> or the unnamed individual responsible for the docketing error at the Whitham law firm;
9. Petitioner has not explained the degree of supervision of Ms. Lucas' work, and no mention is made of any supervision of the unnamed individual responsible for the docketing error at the Whitham law firm;
10. No examples of other work functions carried out have been provided for either Ms. Lucas or the unnamed individual responsible for the docketing error at the Whitham law firm, and;
11. The petition is silent as to any checks on the described work which were used to assure proper execution of assigned tasks in regards to either Ms. Lucas or the unnamed individual responsible for the docketing error at the Whitham law firm.

#### CONCLUSION

Any renewed petition must be filed within **TWO MONTHS** of the mailing date of this decision. **Extensions of time under 37 C.F.R. § 1.136(a) are not permitted.** Any such petition for reconsideration must be accompanied by the \$400 petition fee set forth in § 1.17(h). After decision on the petition for reconsideration, no further reconsideration or review of the matter will be undertaken by the Commissioner. Accordingly, on request for reconsideration, it is extremely important that Petitioner supply any and all relevant information and documentation in order to meet his burden of showing unavoidable delay. This includes statements by all persons with direct knowledge of the cause of the delay, setting forth the facts as they know them. Petitioner must provide documentation and address the deficiencies noted above.

If on request for reconsideration, the delayed payment of the maintenance fee is not accepted, then the maintenance fee is subject to refund following the decision on the petition for

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<sup>18</sup> The Coburn statement of facts alleges Ms. Lucas was "well trained" at paragraph 14, but no details of this training are provided.

reconsideration, or after the expiration of the time for filing such a petition for reconsideration, if none is filed.

The renewed petition should indicate in a prominent manner that the attorney handling this matter is Paul Shanowski, and may be submitted by mail,<sup>19, 20</sup> hand-delivery,<sup>21</sup> or facsimile.<sup>22</sup> Registered users of EFS-Web may alternatively submit a response to this decision via EFS-Web.<sup>23</sup>

Telephone inquiries regarding *this decision* should be directed to the undersigned at (571) 272-3225.<sup>24</sup>



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Paul Shanowski  
Senior Attorney  
Office of Petitions

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19 Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.

20 If responding by mail, Petitioner is advised not to place the undersigned's name on the envelope. Only the information that appears in the footnote should be included - adding anything else to the address will delay the delivery of the response to the undersigned.

21 Customer Window, Randolph Building, 401 Dulaney Street, Alexandria, VA, 22314.

22 (571) 273-8300: please note this is a central facsimile number.

23 <https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html>

24 Petitioner will note that all practice before the Office should be in writing, and the action of the Office will be based exclusively on the written record in the Office. See 37 C.F.R. § 1.2. As such, Petitioner is reminded that no telephone discussion may be controlling or considered authority for Petitioner's further action(s).